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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,797	12/29/2000	Laure Dumoutier	LUD-5543.3 CONT.	5783
24972	7590	08/31/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			GAMBEL, PHILLIP	
			ART UNIT	PAPER NUMBER
			1644	
DATE MAILED: 08/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/751,797

Applicant(s)

DUMOUTIER ET AL.

Examiner

Phillip Gambel

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,10,11,14-16,18,19 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-56 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 8, 10, 11, 14-16, 18, 19, 50-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Applicant's Appeal Brief, filed 6/22/05, is acknowledged.

However, upon a review of the recitation of the claims, the following New Grounds of Rejection have been set forth herein.

The examiner apologizes for any inconvenience to applicant in this matter with respect to the rejection under 35 USC 112, second paragraph.

2. Claims 1, 3, 4, 7, 8, 10-11, 14-16, 18-19 and 50 - 56 are pending.

Claims 2, 5, 6, 9, 12-13, 17 and 20-49 have been canceled previously.

As indicated previously, claims 53-56 appear to be free of the prior art.

3. The text of those sections of Title 35 USC not included in this Action can be found in a prior Action.

Applicant's arguments set forth in the Brief on Appeal, filed 6/22/05, and the examiner's rebuttal are essentially the same of record.

The rejections of record can be found in the previous Office Actions.

See the previous Office Actions for a more complete analysis of applicant's arguments and the examiner's rebuttal.

Applicant's arguments have not been found persuasive.

4. Claims 1, 3, 4, 7, 8, 10, 11, 14-16, 18, 19 and 50-52 stand rejected under 35 U.S.C. 112, first paragraph, because the specification,

while enabling for isolated nucleic acids which encode a T cell inducible factor which is a protein and which activates STAT3, which consists of SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 24 and SEQ ID NO: 25 (and vectors, recombinant cells comprising said nucleic acids)

does not reasonably providing enablement for the broader recitation of nucleic acids which encode a T cell inducible factor which is a protein and which activates STAT3, the complementary sequence of which hybridizes under the claimed stringent conditions to at least one of SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 24 and SEQ ID NO: 25 (and vectors, recombinant cells comprising said nucleic acids) essentially for the reasons of record.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's assertions / arguments and the examiner's rebuttal are essentially the same of record.  
Applicant's arguments have not been found persuasive.

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5. Claims 1, 3, 4, 7, 8, 10, 11, 14-16, 18, 19 and 50-52 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons of record.

For example, the specification discloses a diversity of structure and function of the disclosed T cell inducible factors encoded by nucleic acid molecules consisting of SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 24 and SEQ ID NO: 25.

The specification discloses SEQ ID NOS: 7, 8, 24 and 25 which corresponds to the cDNA encoding the human and mouse species of T cell derived inducible factors. SEQ ID NOS: 7, 8, 24 and 25 meet the written description provisions of 35 USC 112, first paragraph.

However, the instant claims to nucleic acids that encode T cell inducible factors, which encompass "genomic sequences" from "all mammalian species". The claimed nucleic acids encompass genomic sequences, sequences that hybridize to SEQ ID NOS: 7, 8, 24 and 25, corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and so forth. Nucleic acid sequences other than SEQ ID NOS. 7, 8, 24 and 25 do not meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's assertions / arguments and the examiner's rebuttal are essentially the same of record. Applicant's arguments have not been found persuasive.

6. New Grounds of Rejection.

Claim 15 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite in that it depends on a canceled claim.

Applicant is invited to amend the claim to indicate the proper dependency of claim 15.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. New Grounds of Rejection.

Claims 1, 3, 4, 7, 8, 10, 11, 14-16, 18, 19 and 50-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 50 of copending application USSN 10/206,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims of the instant and copending application are drawn to isolated nucleic acids which encode a T cell inducible factor either comprising or consisting of the same SEQ ID NO: 24. Therefore, the claims either anticipate or render the obvious the same nucleic acid molecules encompassing the same SEQ ID NO: 24.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 52-56 appear to be free of the prior art.  
Accordingly, claims 52-56 are deemed allowable.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (571) 272-0844. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phillip Gambel, PhD.  
Primary Examiner  
Technology Center 1600  
August 29, 2005



CHRISTINA CHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600